



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,901	03/31/2004	Georges Harik	7171.P024	9296

7590 04/20/2009
Blakely, Sokoloff, Taylor & Zafman LLP
John P. Ward
12400 Wilshire Boulevard
Seventh Floor
Loas Angeles, CA 90025

EXAMINER

MAUNG, ZARNI

ART UNIT	PAPER NUMBER
----------	--------------

2451

MAIL DATE	DELIVERY MODE
-----------	---------------

04/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/815,901	Applicant(s) HARIK ET AL.	
	Examiner ZARNI MAUNG	Art Unit 2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 20-38 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 20-38, 41-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This action is responsive to the election made on March 4, 2009. The elected claims 1-12, 20-29, 30-38 and 41-49 are presented for examination. Claims 13-19 and 39-40 have been canceled.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12, 20-29, 30-38 and 41-49 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The scope of “An instant messaging system comprising a server...,” and “the method including steps of ...” is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12, 20-29, 30-38 and 41-49 are rejected under 35 U.S.C. 102(a), 102

(e) as being anticipated by Fitzpatrick et al., U.S. Patent Number 7,266,583 (hereinafter Fitzpatrick).

Fitzpatrick discloses a method and system for providing contact management to an instant messaging systems. Fitzpatrick discloses the invention substantially as claimed. Taking claim 1 as an exemplary claim, Fitzpatrick discloses an IM server (column 9, lines 52-55; abstract, lines 22-24) connected to a communication network (column 6, lines 52-54; Fig. 1 displays a server connected to a network); and logic operable on the IM server enabling a first user to browse contacts associated with a second user (column 1, lines 17-21 and 51-56; abstract, lines 22-24), wherein the logic enables the second user to act as an intermediary in response to a request by the first user to add a contact associated with the second user (0030, any participants can be permitted to modify a contact list).

With respect to claim 2, Fitzpatrick discloses the network is the Internet network (column 6, lines 52-54).

With respect to claim 3, Fitzpatrick discloses the logic additionally enables the first user to add and list contacts accessed by browsing the contacts associated with the second user (column 8, lines 11-16, chat session participant 300 of contact list 310 is considered the first user and the contact list 110 is considered as belonging to the second user).

With respect to claim 4, Fitzpatrick discloses the second user groups contacts in distinct separate lists (column 4, lines 48-53), and the first user is enabled to browse contacts in only the second user's list that includes the first user as a contact (column 2, lines 36-38; column 4, lines 66-67; column 5, lines 1-8).

With respect to claim 5, Fitzpatrick discloses a means operable for the second user to enable and disable access by the first user to individual ones or lists of contacts associated with the second user (column 9, lines 11-13; column 2, lines 58-65).

With respect to claim 6, Fitzpatrick discloses a means for the first user to select a screen name from the contacts of the second user (column 6, lines 59-66), which selection adds the selected screen name as a contact for the first user (column 8, lines 7-18).

With respect to claim 7, Fitzpatrick discloses the means for a user to select a screen name is an interactive list (column 6, lines 59-66) displayed to the first user on a display screen (column 6, lines 59-66) of a first computerized appliance connected to

Art Unit: 2451

the IM network (column 9, lines 64-67; ,column 10, lines 1-3) and executing a first instance of client logic of the IM system (column 8, lines 7-16; abstract, lines 22-24).

With respect to claim 8, Fitzpatrick discloses the second user's contacts are stored and displayed on a second computerized appliance (column 9, lines 64-67; column 10, lines 1-3) executing a second instance of client logic of the IM system (column 8, lines 7-16; abstract, lines 22-24).

With respect to claim 9, Fitzpatrick discloses upon the first user selecting a screen name from the contact list of the second instance (column 8, lines 7-14), the second instance sends a message to a third instance of the IM client on the network (column 10; lines 56-64, when a token of introduction can be originated by a first participant, a message sent by a second instance is inherent; column 11, lines 33-34; abstract, lines 22-24), the third instance registered to a person using the selected screen name (column 7, lines 23-28), the message alerting the person using the selected screen name that the first user is adding his name to the first user's contact list (column 11, lines 33-37).

With respect to claim 10, Fitzpatrick discloses the second instance, upon the first user selecting a name from the contact of the second instance (column 8, lines 7-14), acts as an intermediary, sending at least a message to a third instance of the IM client (column 10, lines 56-64, when a token of introduction can be originated by a first participant, a message sent by a second instance is inherent; column 11, lines 33-34; abstract, lines 22-24) registered to the person using the selected screen name (column

Art Unit: 2451

7, lines 23-28), the message seeking approval for addition of the selected screen name to the contact list of the first instance (column 11, lines 33-37).

With respect to claim 11, Fitzpatrick discloses the second instance, upon the first user selecting a screen name from the contact list of the second instance (column 10, lines 64-67; column 11, lines 1-2, first user is considered as user #3, second instance is considered user #1), sends messages (column 11, lines 10-12, second instance is considered user #1) to both the third instance registered to the person using the selected screen name (column 11, lines 33-34; column 71 lines 23-28) and also to the first user at the first instance (column 11, lines 33-34), providing introductory information (column 11, lines 15-24) to each of the two users (column 11, lines 33-34, when a token of introduction is provided to one chat session participant, providing a token of introduction to more than one participant is inherent) about the other of the two users (column 11, lines 15-24, when a token of introduction is created, GUI fields may contain information about the users).

With respect to claim 12, Fitzpatrick discloses the two messages sent (column 11, lines 33-34, when a token of introduction is provided to one chat session participant, providing a token of introduction to more than one participant is inherent) also seek response from the two users granting or withholding authorization (column 11, lines 33-34) for the addition of each user's screen name to the other user's contact list (column 11, 34-37).

With respect to claim 20, Fitzpatrick discloses providing at least first and second instances of an IM client (column 1, lines 51-56; abstract 22-24) on first and second computerized appliances respectively on a network (column 9, lines 64-67; column 10, lines 1-3); and providing a browsing means in the first instance of the IM client (column 1, lines 17-21) to allow browsing screen names in a contact list of the second instance by a first user of the first instance (column 7, lines 6-8, when viewing contact list 110 of the first instance by chat session participant 300, a third user of the instance, browsing screen names by a first user of the first instance is inherent), wherein the second instance acts as an intermediary in response to a request by the first user to add a contact in the contact list of the second instance (0030, participants can permit any other one to modify a contact list).

With respect to claim 21, Fitzpatrick discloses initiating the browsing function by selecting one of a menu line item or an interactive icon (column 6, lines 59-61) in an interactive interface on a display screen (column 6, lines 59-66) one of the computerized appliances (column 9, lines 64-67; column 10, lines 1-3).

With respect to claim 22, Fitzpatrick discloses the network is the Internet network (column 6, lines 52-54) and one or more of the computerized appliances are personal computers connected to the Internet (column 9, lines 64-67; column 10, lines 1-3; Fig: 1, users are connected to the Internet; column 6, lines 52-54).

With respect to claim 23, Fitzpatrick discloses a user of the second instance enabling or disabling access by the browsing user of the first instance (column 1, lines

Art Unit: 2451

51-56 and 67; column 2, lines 1-2) for individual ones or groups of contacts in contact lists of the second instance (column 1, lines 51-56).

With respect to Claim 24, Fitzpatrick discloses selecting a screen name from the contact list of the second instance (column 8, lines 7-14), which adds the selected screen name as a contact in the contact list of the first instance (column 8, lines 7-16).

With respect to claim 25, Fitzpatrick discloses displaying an interactive list of contacts (column 6, lines 59-66) from a contact list of the second instance (column 8, lines 7-14) in a display window (column 6, lines 59-66) of the first computerized appliance (column 9, lines 64-67; column 10, lines 1-3).

With respect to claim 26, Fitzpatrick discloses upon the first user selecting a name from the contact list of the second instance (column 8, lines 7-14), sending a message (column 10, lines 56-64) to a third instance of the IM client on the network (column 11, lines 33-34; abstract, 22-24), the third instance registered to the person using the selected screen name (column 7, lines 23-28), the message alerting the person using the selected screen name that the first user is adding his name to the first user's contact list (column 11, lines 33-37).

With respect to claim 27, Fitzpatrick discloses upon the first user selecting a name from the contact of the second instance (column 8, lines 7-14), acting as an intermediary, .sending at least a message (column 10, lines 56-64) to. a third instance of the IM client (column 11, lines 33-34; abstract, 22-24) registered to the person using the selected screen name (column 7, lines 23-28), the message seeking approval for

Art Unit: 2451

addition of the selected screen name to the contact list of the first instance (column 11, lines 33-37).

With respect to claim 28, Fitzpatrick discloses upon the first user selecting a screen name from the contact list of the second instance (column 8, lines 7-14), sending messages (column 10, lines 56-64) to both the third instance (column 11, lines 33-34; abstract, 22-24) registered to the person using .the selected screen name (column 7, lines 23-28)', and also to the first user at the first instance (column 11, lines 33-34; abstract, 22-24; column 7, lines 23-28), providing introductory information (column 11, lines 15-24) to each of the two users (column 11, lines 33-34, when a token of introduction is provided to one chat session participant, providing, a token of introduction to more than one participant is inherent) about the other of the two users (column 11, lines 15-24, when a token of introduction is created, GUI fields may contain information about the users).

With respect to claim 29, Fitzpatrick discloses the two messages sent (column 11, lines 33-34, when a token of introduction is provided to one chat session participant, providing a token of introduction to more than one participant is inherent) also seek response from the two users granting or withholding authorization (column 11, lines 33-34) for the addition of each user's screen name to the other user's contact list (column 11, lines 34-37).

As per claims 30-38 and 41-49, they do not teach or further define over the limitations recited claims 1-12, and 20-29. therefore, claims 30-38 and 41-49 are also rejected for the same reasons set forth in claims 1-12 and 20-29, supra.

Response to Arguments

Applicant's arguments filed on October 22, 2008 have been fully considered but they are not persuasive. As per applicants' arguments filed on October 22, 2008, the applicants argued in substance that Fitzpatrick fails to disclose "the logic enables the second user to act as an intermediary in response to a request".

In reply, Fitzpatrick teaches that anyone of the participants can be permitted modify a contact list of the other participant, thereby allowing to participant to acts as an intermediary in response to the request of the participant who is modifying the list (0030-0031).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zarni Maung whose telephone number is (571) 272-3939. The Examiner can normally be reached on Monday-Friday from 8:30 to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, John Follansbee can be reached at (571) 272-3964. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700. Information regarding the status of an application may be obtained from the Patent

Art Unit: 2451

Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450**

Hand carried or delivered to:

Customer Service Window located at the Randolph Bldg. 401
Dulany St. Alexandria, VA 22314

Faxed to the Central Fax Office:

(571) 273-8300 (New Central Fax No.)

Or Telephone

(571) 272-2100 for TC 2100 Customer Service Office.

/Zarni Maung/

Primary Examiner, Art Unit 2451